



4

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/380,583 09/08/99 NAGATA

S P7331-9002

EXAMINER

MM91/0615

NIKAI DO MARME LSTEIN MURRAY AND ORAM  
METROPOLITAN SQUARE  
655 FIFTEENTH STREET NW  
SUITE 330 G STREET LOBBY  
WASHINGTON DC 20005-5701

SUNDARAM, T

ART UNIT

PAPER NUMBER

2858

DATE MAILED:

06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/380,583

Applicant(s)  
Shinichi Nagata et al.

Examiner  
T. R. Sundaram

Art Unit  
2858



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Apr 24, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-12 is/are pending in the applica

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from considera

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-12 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirem

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

Art Unit: 2858

## DETAILED ACTION

### *FOAM and Applicants' Response*

1. A First Office Action on Merits (FOAM) was issued on the subject application on October 24, 2000. In the FOAM, claims 1-12 (with claims 1, 2 and 3 being independent claims, had been rejected under 35 U.S.C. 103(a) as being unpatentable over *King*, in view of *Osaki et al.*, *Heikkila* and *Todoroki et al.* In their response to the FOAM, received by the Office on April 24, the Applicants have not made any amendments to the claims in light of the rejections given in the FOAM, but have merely traversed the rejections. They contend: "Applicant [sic] respectfully asserts that the rejection of claims 1-12 is improper for failing to teach or suggest all of the elements of the claims."

The Applicants' arguments have been considered in full by the Examiner, but he finds them unpersuasive. Therefore, the earlier rejections are reaffirmed herein and the rejection is made **FINAL**.

In the following, we first repeat the earlier rejections of claims 1-12 as being unpatentable over *King*, in view of *Osaki et al.*, *Heikkila* and *Todoroki et al.*, with appropriate modifications to take into account some of the Applicants' arguments. Then the Applicants' arguments are considered in detail, and it is shown why they are unpersuasive, based both in terms of the cited art and relevant case law. The rejection is then made **final**.

Art Unit: 2858

***Drawing Corrections***

2. In the FOAM we had required that Figs. 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. In their response to the FOAM, the Applicants have submitted drawing corrections in which Figs. 1 and 2 are designated as prior art; the proposed correction is approved.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over *King*, in view of *Osaki et al.*, *Heikkila* and *Todoroki et al.*

Before considering claims 1, 2 and 3 (the independent claims in the application), we note that, as a general rule, any recitation of use in the preamble of a claim is "nonlimiting unless it breathes life and meaning into the claim" (MPEP § 2111.02). That is, the preamble is **not** given any weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process or structure is able to stand alone - *In re Hirao*, 535, F.2d 67, 80 USPQ 15 (CCPA 1976). On the other hand, in apparatus claims, any phraseology in the preamble that limits the

Art Unit: 2858

structure of the apparatus is given patentable weight - *In re Stencel*, 828, F.2d 751, 4 USPQ 2d 1071 (Fed. Cir. 1987).

By the principle just cited, the recitation “an orientation measuring instrument” in the preambles of claims 1, 2 and 3 is not given any patentable weight since it does not “breathe life and meaning into the claim.” Indeed, the term “orientation” is nowhere recited in the body of the claim, nor is an instrument for measuring it mentioned.

Now, regarding claim 1, *King* discloses a detection apparatus/instrument (Figs. 1 and 2) that discloses: one “dielectric resonator” (11, Figs. 3A, 3B and 3C) comprising a plane being close to or in contact with (line 1, abstract) a sample (9) and arranged only on one surface side of the sample (Figs. 1, 3A, 3B and 3C); a microwave exciter (2, Fig. 1 and column 12, lines 3 ff) generating an electric field vector (column 7, lines 24-26) having a unidirectional component (column 11, lines 27-41) at a frequency in the vicinity of the resonance frequency (abstract and column 2, lines 38-68; especially lines 43-46 and lines 59-60) of the said “dielectric resonator” (11) when the sample is present (Figs. 1 and 3A-C) and in an in-sample plane parallel to said plane in the dielectric resonator (Figs. 3A-C); a detector (6A, Fig. 1) for detecting transmission energy (column 1, line 20 to column 2, line 7) or reflection energy (title, abstract and column 2, lines 30-32) by said “dielectric resonator” (11); and a data processor obtaining dielectric anisotropy (column 4, lines 32-49) of the sample from the variance of the detection output of said detector (Fig. 1).

Art Unit: 2858

In the foregoing, we have quoted the language of claim 1 *verbatim*, except for lines 10-11, and have demonstrated that they **read on King**. As indicated by the quotation marks, and as will be explained in detail presently, we have considered the microstrip resonator of *King* to be “equivalent” to, under the Doctrine of Equivalence, the dielectric resonator recited in the claim. [We also note that *King* does not expressly consider the microwave energy transmitted through the sample, albeit it is noted that line 8 of the claim recites transmitted energy **only in the alternative**; that is, the recitation is transmission energy **or** reflection energy. As we have pointed out, in *King*, transmission is, however, mentioned as a part of well-known prior art.]

As we have already alluded to, *King* does not expressly disclose a rotation mechanism for rotating the sample under test or the resonator. Although the apparatus of *King* is **not** expressly designed for measuring orientation, the disclosure specifically mentions determination of fiber orientation (column 4, lines 41-49) as one possible application. Also, as already explained, the recitation “an orientation measuring instrument” in the preambles of claim 1 has not been given any patentable weight.

Rotating the sample or the resonator is, however, widely practiced in the art, as is the use of a transmission mode of testing, as exemplified by *Osaki et al.*, *Heikkila* and *Todoroki et al.* *Osaki et al.* discloses a method of determining orientation or dielectric characteristics of thin sheet materials in which both the sheet material under test (3) and the microwave unit (1 and 2) can be rotated (respectively, Figs. 1 and 3). *Heikkila* discloses a method of determining grain direction in wood using both transmitted and reflected microwave energy (respectively Figs. 2 and 3).

Art Unit: 2858

*Todoroki et al.* discloses a method of determining fiber orientation in paper through the use of a polarized laser beam (another form of radiation than microwaves, albeit also electromagnetic radiation), in which the sample table (2a, Figs. 2 and 3), containing the sample sheet (1a) is rotated with respect to the beam.

*King, Osaki et al., Heikkila and Todoroki et al.* are analogous art, with all of them being concerned with the measurement of the dielectric properties of sheet-like materials.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the invention of *King*, in view of the teaching of *Osaki et al., Heikkila and Todoroki et al.*, and to have arrived at the invention of claim 1.

The suggestion/motivation for doing so would have been that, as already noted, relative rotation between the sample and the microwave source, as well as a transmission mode of testing, are both widely used in the art. **Indeed, the Applicants' own admitted prior art (Fig. 1) includes the former (namely, rotation) feature as being well known in the art.** In page 2, lines 27-30 of the Applicants' own specification, it is stated: "The sample 10 [in Fig. 1, which is admitted prior art] is **rotated** around the axis of the resonator 6, and the intensity of the transmitted microwave is detected **every** rotational angle for obtaining the orientation pattern" (emphasis added).

Therefore, claim 1 is obvious and unpatentable over *King*, in view of *Osaki et al., Heikkila and Todoroki et al.*

Art Unit: 2858

As already noted, in the foregoing rejection we have considered the microstrip resonator of *King* to be “equivalent”, under the Doctrine of Equivalence, to the dielectric resonator recited in the claim. It is a well-established concept in determining patentability (MPEP § 904.01(b), 2144.06, 2183 and 2184) that substitution of **functional** or mechanical equivalents for a claimed component can be used as a rationale supporting an obviousness rejection (MPEP 2144.06). Specifically: “If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed invention is anticipated by the prior art element.” (MPEP 2183). The only requirement required to support the substitution is that the equivalency must be recognized in the prior art (MPEP 2144.06). It is, however, **not** necessary that an **express** suggestion exist to render such substitution obvious; *In re Fout* 675 F.2d 297, 213 USPQ 532 (CCPA 1982). In this context, it is relevant to note that the resonators 12 a and 12b, in Fig. 2 of the application (which is **admitted prior art**, and is from a Japanese laid-open patent application) are **dielectric resonators**, and are so identified in lines 4-6, page 3 of the present application.

Thus, in the present case, considering the microstrip resonator of *King* to be “equivalent” to the dielectric resonator recited in the claim, is well supported by established patent examining practice, prior art (including Applicants’ own admitted prior art) as well as case law.



Art Unit: 2858

Regarding claim 2, this independent claim recites essentially the same structural elements as in claim 1, but a plurality of resonators is used, rather than sample rotation, to determine orientation. *King* discloses an operational mode involving a plurality of resonators (Fig. 7).

Regarding claim 3, this independent claim recites essentially the same elements as in claims 1 and 2, but the plurality of microwave generators and detectors are driven sequentially. As already noted, *King* discloses a plurality of resonators arranged at different locations (Fig. 7). Driving these sequentially, according to a preselected protocol, is an obvious and unpatentable engineering design variation. *King* specifically notes that several obvious variations to the specific configurations disclosed, including the multiple resonator configuration in Fig. 7, are possible (column 15, lines 7 ff). Moreover, the use of switches and shift registers to sample a series of sensors sequentially is a commonly used technique in the semiconductor arts.

Regarding claims 4 and 5, since *King* discloses a data processing unit (Fig. 1), specific **functions** that can be performed by this unit do not constitute additional limitations. It should be emphasized that “apparatus claims must be structurally distinguishable from the prior art.” MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of **structure** rather than **function**. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: “Apparatus claims cover what a device **is**, not what it **does**.” (emphasis in original). That is, in an **apparatus** claim, if a prior art structure discloses all of the **structural elements** in the claim, as well as their relative juxtaposition, then it reads on the claim,

Art Unit: 2858

regardless of whether or not the **function** for which the prior art structure was intended is the same as that of the claimed invention.

Regarding claims 6 and 7, *Heikkila* discloses (Figs. 2 and 3) oppositely arranged elements to detect transmission energy (Fig. 2), as well as sensor arrangements for detecting reflection energy (Fig. 3).

Regarding claims 8-12, *King* discloses (column 15, lines 7 ff) that various shapes (lines 14-15) of the resonator are possible, as are various orientations (lines 16-18) and types of shielding (lines 19-22).

### ***Discussion of the Applicants' Arguments***

5. The Applicants begin their response to the rejections in the FOAM by first asserting: "... elements of the claims are not taught or suggested by the references and that the motivation supplied by the Examiner is insufficient to support the rejection of the claims" (page 2 of response). In section 4 above, we have demonstrated, by quoting the language of claim 1 **verbatim**, that it reads on *King*, except for the feature of "rotating said sample or said dielectric resonator." The last feature, however, is **Applicants' own admitted prior art** (Figs. 1-2 of the application and pages 1-2 of the specification). Therefore, the Applicants assertion is without any basis either in fact or in governing patent statutes. Nevertheless, we will consider below the Applicants' arguments in detail, and demonstrate that each one of them is unpersuasive.

Art Unit: 2858

The Applicants begin their traverse by giving brief descriptions of their invention and *King* (page 2 of response), and they contend that “resonator 20 of the present application is a dielectric resonator. On the contrary, *King* discloses a microstrip resonator, which is different from a dielectric resonator” (page 3). They then give a detailed accounting of how their invention **functions** differently from one using a microstrip resonator in general, and *King* in particular. They argue: “A microstrip resonator is different from a dielectric resonator in its **operating** principles ...” (emphasis added).

Two important points need to be made with regard to the foregoing argument. First, as we have already emphasized: “apparatus claims must be structurally distinguishable from the prior art.” MPEP 2114. To repeat, if a prior art structure discloses all of the **structural elements** in the claim, then it **reads** on the claim, regardless of whether or not the **function** for which the prior art structure was intended is the same as that of the claimed invention.

The second point concerns the doctrine of equivalence and equivalents. As we have already noted, substitution of **functional** or mechanical equivalents for a claimed component can be used as a rationale supporting an obviousness rejection (MPEP 2144.06). In *GRAVER TANK & MFG. CO., INC., et al. v. THE LINDE AIR PRODUCTS COMPANY*, 85 USPQ 328 (US SupCt 1950), it was held that: “What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a

Art Unit: 2858

vacuum. **It does not require complete identity for every purpose and in every respect** (emphasis added).

Thus, unless there was some particular language in claim 1 that specifically required the use of a **specific type** of resonator (and there is not, as the claim is presently recited), it is perfectly proper to use an equivalent in an obviousness rejection.

Regarding the dielectric resonator, the Applicants' argue (page 3 of response) that it "produces a **strong electromagnetic coupling**" and as a result "can determine dielectric isotropy with **high sensitivity**" (emphases added). Presumably, by contrast, the resonator of *King* "may be able to **determine dielectric anisotropy**, however, the **sensitivity is low**" (page 4, emphases added).

In this argument, the Applicants are relying on facts not stated in the claim, since claim 1 says nothing whatsoever about "sensitivity" or "strong electromagnetic coupling". The only relevant recited limitation that pertains to the present context is "obtaining dielectric anisotropy of the sample" (line 12 of claim 1), which, in the passage just quoted, the Applicants themselves **admit** that *King* provides.

Now, if there was some special **structural and/or functional** aspect of the Applicants' invention that render it patentably distinct over prior art, then this has to be clear from the **claims themselves**; the Applicants cannot rely on the specification or on arguments that they advance to the Examiner in an amendment. **That is, they cannot rely on factors not recited in the rejected claims.** Although the claims are interpreted in light of the specification, **limitations from the**

Art Unit: 2858

**specification are not read into the claims.** See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). See also *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571-72 7 USPQ2d 1057, 1064-1065 (Fed. Cir.), *cert denied*, 488 U.S. 892 (1988), in which it was held that various limitations on which the appellant relied could not be given meaning since they **were not stated in the claims**. In *Ex parte McCullough*, 7 USPQ2d 1889, 1891 (Bd. Pat. App. & Inter. 1987), a claimed electrode was rejected although it was asserted in the **specification** that it functions differently from prior art electrodes, since “although the demonstrated results may be germane to the patentability of a battery containing appellant’s electrode, they are not germane to the invention claimed on appeal.”

Now, turning to claims 2 and 3, the Applicants argue (page 4 of the response) that in claim 2 “there are provided a plurality of dielectric resonators” while in claim 3 “there are a plurality of sets of microwave exciters and detectors.” It should be pointed out that in *In re Herza*, 374 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance, unless a new and unexpected result is produced by such duplication.

The Applicants then discuss the functional aspects of the secondary references, and argue (pages 5-7 of the response) that there is a lack of motivation to combine the references cited, and that the Examiner has not established a *prima facie* case for combining the references. They quote the Examiner’s statement that: “Rotating the sample or the resonator is, however, widely practiced in the art, as is the use of a transmission mode of testing, as exemplified by *Osaki et al.*,

Art Unit: 2858

*Heikkila and Todoroki et al. Osaki et al.*,” and argue that “this does not supply motivation but instead alleges the possibility that the references can be combined. There is no reason provided that suggests any benefit from the combination” (page 7 of response).

First, we point out that we specifically cited the secondary references (*Osaki et al.*, *Heikkila and Todoroki et al. Osaki et al.*) only as **exemplars** in support of our statement that both rotation and transmission mode of testing are well-known engineering design variations in the art. There is no actual “combining of references involved in here; only that the **teachings** of the secondary references suggest well-known engineering design variations. As we have pointed out in section 4 above, **the Applicants’ own admitted prior art (Fig. 1) shows rotation** and on page 2, lines 27-30 of the Applicants’ own specification, it is stated: “The sample 10 [in Fig. 1, which is admitted prior art] is **rotated** around the axis of the resonator 6, and the intensity of the **transmitted** microwave is detected every rotational angle for obtaining the orientation pattern” (emphases added).

*King* also discloses the transmission mode of testing as well-known prior art (column 1, lines 54-55). Moreover, claim 1 recites detection of transmission energy **only in the alternative** (line 8). For all of the aforementioned reasons, the Applicants’ argument that there is “no reason provided that suggests any benefit from the combination” is incorrect as well as unpersuasive.

Although motivation to **combine** references is not an issue here, we will nevertheless briefly address the issue since the Applicants misrepresent the case law precedents. The Examiner is well aware of the general principle that obviousness can only be established by combining or

Art Unit: 2858

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves, in the knowledge generally available to one of ordinary skill in the art, in established scientific principles, or in legal precedent established by prior case law. The rationale to combine need not, however, be expressly stated in prior art; implication is sufficient. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) legal precedent was deemed sufficient basis, while in *In re Nilssen*, 851 F.2d, 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) it was held that references **do not** have to explicitly suggest combining teachings; the court expressly **rejected** a request to “establish a ‘reality based’ definition whereby, in effect, references may not be combined to formulate obviousness rejections absent an express suggestion in one prior art reference to look to another specific reference.” In *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) it was held that the rationale to combine references may be based on logic and sound scientific reasoning.

The Applicants also argue (page 6 of response), contending that *Todoroki et al.* “teaches away” from “combining” references, that in *Panduit Corp. v. Dennison Manufacturing Co.* (CA FC) 1 USPQ2d 1593, it was held that “a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); elements of separate prior patents cannot be combined when

Art Unit: 2858

there is no suggestion of such combination anywhere in those patents, *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

But, as already noted, in *In re Nilssen*, the court **expressly rejected** a request to "establish a 'reality based' definition whereby, in effect, references may not be combined to formulate obviousness rejections absent an **express suggestion** in one prior art reference to look to another specific reference" (emphasis added). The court then continued: "We **reject** that recommendation as **contrary to our precedent** which holds that for the purpose of combining references, those references **need not** explicitly suggest **combining teachings, much less specific references**."

See, e.g., *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983); *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)" (emphases added).

In several **recent** landmark decisions, the Courts have clarified the requirements of factual findings regarding motivation, suggestion or teaching to combine references in rejections under 35 U.S.C. 103(a); they have held that factual findings must be supported by "substantial evidence." *Dickenson v. Zurko*, 257 U.S. 150, 119 S. Ct 1816, 144 L. Ed 143 (1999); *In re Gartside*, 203 F.3d 1305, 33 U.S.P.Q.2d 1769 (Fed Cir. 2000); *In re Kotzab* ---F3.d----, 2000 WL 89279 (Fed. Cir. June 30, 2000). Substantial evidence is defined as something less than the weight of the evidence, but more than a mere scintilla of evidence. The test is whether "a reasonable mind might accept the evidence as adequate to support the factual conclusion."



Art Unit: 2858

We believe that we have met the aforementioned test of what "a reasonable mind might accept the evidence as adequate to support the factual conclusion." We have also provided more than a mere scintilla of evidence.

If the Applicants believed that their invention, as described in the specification, was patentable over prior art, then they should have amended the claims, in light of the rejections given in the FOAM, to clearly delineate the patentable features in the claims themselves. Instead, they have chosen not to amend the claims and to provide unpersuasive arguments on the patentability of the claims in their rejected form. Therefore, the Examiner has no choice but to reiterate the earlier rejections, and to make the rejection **FINAL**.

***Final Rejection***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2858

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Conclusion*

7. Any inquiry concerning this communication should be directed to Dr. T. R. (Joe) Sundaram at telephone number (703) 306-6821. If attempts to reach the Examiner by phone are unsuccessful, the Examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436.

TRS 

TRS

June 14, 2001

  
Safet Metjahic  
Supervisory Patent Examiner  
Technology Center 2800